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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/825,361 03/26/97 MOSSELMAN

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EXAMINER

HM12/0131

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PAK, M

ART UNIT

PAPER NUMBER

1546

17

DATE MAILED:

01/31/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/826,361

Applicant(s)

Mosselman et al.

Examiner

Michael Pak

Group Art Unit

1646



☒ Responsive to communication(s) filed on Jul 30, 1999

☒ This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-12 and 14-18 is/are pending in the application.

Of the above, claim(s) 9-11, 14, and 18 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-8, 12, and 15-17 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

**DETAILED ACTION**

1. Amendment filed 30 July 1999 (Paper No. 16) has been received and entered.
2. Applicant's arguments filed 30 July 1999 (Paper No. 16) have been fully considered but they are not found persuasive.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. This application contains claims 9-11, 14, and 18 drawn to an invention non-elected without traverse in Paper No. 3. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) MPEP § 821.01.
5. Rejection under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicants arguments.
6. Rejection under 35 U.S.C. 102 and 103 as anticipated by KARO BIO AB is withdrawn in view of applicants arguments.

***Claim Rejections - 35 USC § 102***

7. Claims 1-8, and 15-17, remains rejected under 35

Serial Number: 08/826,361  
Art Unit: 1646

2

U.S.C. 102(e) as being anticipated by Kausch et al.((A); U.S. '164) for the reasons set forth in the last office action.

Applicants argue that Kausch differs from the present invention in that it discloses a method for the isolation and sorting of chromosomes in general and is not concerned with the DNA per se, whereas the present invention relates to the cloning of a particular DNA and its use in medical research. However, the claims do not exclude the chromosomal DNA disclosed in Kausch et al. and the claims are not limited to the cloning of a particular DNA and its use in medical research.

Applicants argue that the teaching disclosed in Kausch et al. is nothing more than a general teaching about hypothetical uses of the method and can by no means be interpreted as a specific teaching for the isolation and cloning of ER-beta DNA. However, as discussed in the last office action, the chromosomal DNA inherently comprises the DNA claimed and thus anticipates the claims. Applicants further argue that if this would be the case, then for the same reasons applied to Kausch et al. rejection, the Maniatis Laboratory Manual of Cloning would have anticipated all nucleotide sequences that haven been cloned subsequent to its publication. However, Kausch et al. anticipates the claims as discussed above because the chromosomal DNA is disclosed. Whether Maniatis anticipates the present claims has not previously addressed. If Maniatis discloses the

human chromosomal DNA, the claims will be anticipated by the reference.

Applicants argue that Kausch et al. Teaching in Example 2 concerns the isolation and sorting of human chromosome 1 which does not comprise the DNA encoding ER-beta which is located on chromosome 14. However, the Kausch et al. teaches that many chromosomes can be sorted at once (column 9, lines 29-43), which includes all the chromosomes in the cell.

8. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Evans et al. ((B); U.S. '233).

Evans et al. teach DNA encoding chimeric receptor of nuclear or steroid receptor family members including estrogen receptor and a method of screening for ligands using the chimeric receptors (column 7, lines 19 to column 8, line 31).

Newly amended claim 12 encompasses one of the domains of claim 1 which is the DNA encoding the DNA binding domain of estrogen receptor which is taught by Evans et al. Evans et al. teach the remaining chimeric receptor comprising other domains of nuclear receptors (column 7, lines 19 to column 8, line 31).

9. No claims are allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday

Serial Number: 08/826,361  
Art Unit: 1646

4

from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310.

Official papers filed by fax should be directed to (703) 308-4242.  
Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Michael D. Pak*

Michael Pak  
Primary Patent Examiner  
Art Unit 1646  
2 October 1999

*Anthony Caputo*  
*Apr 16 '99*